

REMARKS / ARGUMENTS

The present application includes pending claims 1-18, all of which have been rejected. By this Amendment, claims 7-12 and 17 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. New claims 19-25 have been added. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 7-12 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Claims 7-12 are rejected under 35 U.S.C. § 112, first and second paragraph. Claims 1-4, 7-9 and 13-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,049,533, issued to Norman et al. (hereinafter, Norman), in view of U.S. Patent No. 5,896,373, issued to Mitts, et al. (hereinafter, Mitts). Claims 5, 6, 11, 12, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Norman, in view of Mitts, and further in view of U.S. Patent No. 4,481,670, issued to Freeburg (hereinafter, Freeburg). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

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I. REJECTION UNDER 35 U.S.C. § 101

The Applicant first turns to the rejection of claims 7-12 under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter.

The Applicant respectfully traverses this rejection, but nevertheless has amended claims 7-12. Furthermore, the Applicant has amended paragraph 21 of the specification so that the specification is conforming to the newly amended claims 7-12. No new matter has been introduced by the claim and specification amendments.

The Examiner is referred to the following citation from the MPEP:

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, **“functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component.** (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) **“Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.**

See Manual of Patent Examining Procedure (MPEP), Chapter 2100.6. The Applicant points out that the descriptive material in the preamble of claim 7 is not related to “music, literary works, and a compilation or mere arrangement of data.” Instead, the Applicant submits that the descriptive material in the preamble

of claim 7 is related to “computer programs which impart functionality when employed as a computer component.” In other words, the material in the preamble of claim 7 is “functional descriptive material.” The Examiner is also referred to the following MPEP citation for support:

When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

See *id.* The Applicant, therefore, submits that the material in the preamble of claim 7 is functional descriptive material, which is also statutory, as per the above MPEP guidelines. The Applicant submits that claims 7-12 are directed to statutory subject matter, and that the rejection of claims 7-12 under 35 USC § 101 should be withdrawn.

II. Rejection of Claims 7-12 under 35 U.S.C. § 112, 1st ¶

Claims 7-12 were rejected under 35 U.S.C. § 112, 1st ¶, as allegedly failing to comply with the written description requirement. The Applicant respectfully traverses this rejection, but nevertheless has amended claims 7-12. Furthermore, the Applicant points out that support for the “computer-readable medium” claims 7-12 may be found at, for example, paragraphs 19-23 and 79-82. The Applicant

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submits that claims 7-12 comply with the written description requirement, and that the rejection of claims 7-12 under 35 USC § 112, 1st ¶ should be withdrawn.

III. Rejection of Claims 7-12 under 35 U.S.C. § 112, 2nd ¶

Claims 7-12 were rejected under 35 U.S.C. § 112, 2nd ¶, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Applicant respectfully traverses this rejection, but nevertheless has amended claims 7-12. The Applicant submits that the rejection of claims 7-12 under 35 USC § 112, 1st ¶ should now be withdrawn.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (“MPEP”) states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that “the mere fact that

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references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference to do so*'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...," citing *AI-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

IV. The Proposed Combination of Norman and Mitts Does Not Render Claims 1-4, 7-9 and 13-16 Unpatentable

The Applicant now turns to the rejection of claims 1-4, 7-9 and 13-16 as being unpatentable over Norman in view of Cromer.

A. Independent Claim 1

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Norman and Mitts does not disclose or suggest at least the limitation of "requesting from said at least one of a plurality of access points, a status of said at least one access device located within said coverage area of said at least one of a plurality of access points," as recited by the Applicant in independent claim 1.

With regard to Norman, the Office Action concedes the following:

Norman disclose all of the subject matter of the claimed invention except a requester (see Figure 2 Box 222, AP programmed to request) sending/requesting from the at least one of a plurality of access points, a status of the at least one access device located within a coverage area of the at least one of a plurality of access points and receiving from the at least one of a plurality of access points within whose coverage area the at least one access device is located, at least one status reply message indicating a status of the at least one of a plurality of access devices.

See the Office Action at page 5 (emphasis added). The Examiner then relies on Mitts and states the following:

Mitts from the same or similar fields of endeavor teaches a requester (see Figure 1 Box 5) sending/requesting from the at least one of a plurality of access points, a status of the at least one access device located within a coverage area of the at least one of a plurality of access points (Figure 2a and column 5 lines 41-51, the requester sends and receives a status message or reply from the access point) and receiving from the at least one of a plurality of access points within whose coverage area the at least one access device is located, at least one status reply message indicating a status of the at least one of a plurality of access devices (Figure 2a

and column 5 lines 41-51, the access point replies with a status message).

See the Office Action at page 5. The Applicant respectfully disagrees with the above argument. Referring to Figure 1 of Mitts, the Examiner alleges that switch 5 is the “requester”, or the device which performs the “requesting” limitation from Applicant’s claim 1. The Examiner further relies on the following citation:

When the mobile terminal 1 senses that the connection to the old access point 2 is weakening, it makes a decision to start the handover procedure. **The mobile terminal 1 sends a HO_REQUEST message, which the access point 2 transmits to the switch 5.** The message contains, among others, a list in order of preference of those access points to which the mobile terminal 1 can hand over, i.e. that it hears. As a response to the HO_REQUEST message, the switch 5 can now select the new access point directly, or it can send a status enquiry, i.e. a RR-STATUS_ENQUIRY message to all access points in the list or to only part of them in order to find out how the different access points could take over the new connection. Now each access point that has received the status enquiry checks the situation, makes a preliminary reservation of the required resources and responds to the switch with a RR-STATUS message to indicate whether the connection can be transmitted or not and what is the identifier of the preliminary reservation.

See Mitts, col. 5, lines 34-51. With regard to the HO_REQUEST message, as clearly stated in the above citation, it is the mobile terminal 1 (Figure 2a of Mitts), and not the switch 5 (equated by the Examiner to the “requester”) that sends the HO_REQUEST message to the access point 2, and then to the switch 5. With

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regard to the RR-STATUS_ENQUIRY message, Mitts discloses that the switch 5 sends this status enquiry to the access points 2 for purposes of finding out "how the different access points could take over the new connection." More specifically, in response to the status enquiry message from the switch 5, each access point "checks the situation, makes a preliminary reservation of the required resources and responds to the switch with a RR-STATUS message to indicate whether the connection can be transmitted or not and what is the identifier of the preliminary reservation." See Mitts at col. 5, lines 46-51. In this regard, Mitts does not disclose or suggest that the switch, via the RR-STATUS_ENQUIRY message, requests from the access points "a status of said at least one access device located within said coverage area of said at least one of a plurality of access points." Also, in response to the RR-STATUS_ENQUIRY message, none of the access points 2 provide "a status of said at least one access device located within said coverage area of said at least one of a plurality of access points," as recited in Applicant's claim 1.

Therefore, the Applicant maintains that the combination of Norman and Mitts does not disclose or suggest at least the limitation of "requesting from said at least one of a plurality of access points, a status of said at least one access device located within said coverage area of said at least one of a plurality of access points," as recited by the Applicant in independent claim 1. Accordingly, the proposed combination of Norman and Mitts does not render independent claim 1

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unpatentable, and a *prima facie* case of obviousness has not been established.

The Applicant submits that claim 1 is allowable.

Independent claims 7 and 13 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 7 and 13 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-4, 8-10 and 14-16

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 7 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Norman in view of Mitts has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-4, 8-10 and 14-16 depend from independent claims 1, 7 and 13, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-4, 8-10 and 14-16.

V. The Proposed Combination of Norman, Mitts and Freeburg Does Not Render Claims 5, 6, 11, 12, 17 and 18 Unpatentable

Since the additional cited reference (Freeburg) does not overcome the deficiencies of Norman and Mitts, claims 5, 6, 11, 12, 17 and 18 depend from

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independent claims 1, 7 and 13, respectively, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 5, 6, 11, 12, 17 and 18.

VI. New Claims 19-25

The Applicant has added new claims 19-25. The new claims are substantially similar to the existing system claims 13-18. In addition, support for the new claims may be found in, for example, paragraphs 19-24 of the specification. The Applicant submits that no new matter has been introduced by the new claims 19-25.

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CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-18 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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